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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1970

No. 873

ST. ELMO HAWKINS, *Petitioner*

v.

GENERAL MOTORS CORPORATION, GEORGE R. JONES, T/A BEALE AND JONES, and CHEVROLET MOTORS CORPORATION, *Respondents*

## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals entered in the above-entitled case on May 21, 1970.

### CITATIONS TO OPINIONS BELOW

Petitioner St. Elmo Hawkins filed this action against Respondents in the Federal District Court for the Eastern District of Virginia. Following presentation of the Petitioner's evidence, the Complaint was dismissed upon motion of Respondents under Rule 41(b),

Federal Rules of Civil Procedure. The case is unreported. Petitioner then filed his appeal with the United States Circuit Court of Appeals for the Fourth Circuit. The appeal was denied. Copies of the informal and formal findings of fact of the District Court and the decision of the Court of Appeals are included as Appendixes A, B and C to this Petition.

## JURISDICTION

The judgment of the United States Court of Appeals for the Fourth Circuit was entered on May 21, 1970. On August 14, 1970, this Court entered an order extending the time for filing the Petition for Writ of Certiorari to October 18, 1970. The grounds for Petitioner's request were the illness of his previous counsel and the fact that present counsel were not engaged until August 6, 1970. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

## STATEMENT

On April 20, 1956, Petitioner went to the offices of Respondents Beale and Jones, a patent law firm, and took with him three drawings depicting an internal combustion engine manifold. Following consultation with a member of the firm, an independent draftsman was employed by Beale and Jones to develop a new set of drawings for purposes of patent application. The drawings were developed and sent to Petitioner on May 18 and June 20, 1956. Correspondence ensued between Beale and Jones and Petitioner until November 20, 1956, when Petitioner furnished Beale and Jones additional drawings of his invention. In August, 1957, Petitioner directed Beale and Jones to make a search of the patent office. Following the

search, Beale and Jones informed Petitioner, on October 11, 1957, that his idea was unpatentable, except for a possible patent of limited scope.

In early 1960, Petitioner discovered that his invention had been patented by one A. E. Kolbe, an employee of General Motors Corporation. The application for this patent was filed on December 6, 1956, and the patent was granted on April 21, 1959. Petitioner immediately went to the offices of Beale and Jones in May, 1960, and inquired as to how Kolbe and General Motors had patented his invention. Beale and Jones agreed to investigate the matter, and on June 28, 1960, informed Petitioner that the Kolbe patent did not read on Petitioner's invention.

At the time Petitioner disclosed his invention to Respondents Beale and Jones, their offices were contiguous to the Patent Office of Respondent General Motors Corporation. Within seven months of the disclosure to Beale and Jones, Respondent General Motors, through their employee Kolbe, had applied for a patent on Petitioner's invention. (A copy of Petitioner's invention and a drawing from the Kolbe patent are set out as Appendixes D and E hereto.) Notwithstanding the fact that his name appeared on the patent, Kolbe testified that he had never invented anything, much less Petitioner's manifold.

Petitioner filed this action under 28 U.S.C. § 1332 and 28 U.S.C. § 1331, alleging negligence of Respondents Beale and Jones and a violation of the Sherman Act, 15 U.S.C. §§ 1-7 and the Clayton Act, 15 U.S.C. §§ 12-27.

On January 24, 1969—the same day as the filing of his final pleading—Petitioner made his demand for

a trial by jury. The demand was denied. Following presentation of Petitioner's evidence, and upon motion by Respondents under Rule 41(b), Federal Rules of Civil Procedure, Petitioner's case was dismissed. The decision of the District Court was affirmed by the United States Court of Appeals for the Fourth Circuit.

## REASONS FOR GRANTING THE WRIT

1. Petitioner has been denied his right to trial by jury as guaranteed by the Seventh Amendment to the United States Constitution. Petitioner filed this action in the United States District Court for the Eastern District of Virginia in August, 1967. An amended complaint was filed on October 18, 1967. A further amended pleading, adding parties defendant, was filed on April 28, 1968. At the pretrial hearing on January 24, 1969, Petitioner was granted leave to file three amendments to the Complaint including:

(1) The allegation that Chrysler Motors Corporation secured a patent containing the same idea as Plaintiff's invention;

(2) An additional prayer for relief requesting a declaration that Petitioner is the owner of the aforesaid patent; and

(3) An additional prayer for relief enjoining Respondent from appropriating Petitioner's invention. (Tr. 134-136)

These amendments were allowed upon written motion to the District Court (Appendix F hereto). In the same written motion Petitioner included his demand for trial by jury (Appendix F hereto). Immediately after granting Petitioner leave to file the aforesaid amendments, Petitioner's demand for trial by jury was denied (See *infra.*)

Rule 38 of the Federal Rules of Civil Procedure states, in pertinent part, as follows:

> (a) RIGHT PRESERVED. The right of trial by jury as declared by the Seventh Amendment to the Constitution or as given by a statute of the United States shall be preserved to the parties inviolate.
>
> (b) DEMAND. Any party may demand a trial by jury of any issue triable of right by a jury by serving upon the other parties a demand therefor in writing at any time after the commencement of the action and not later than 10 days after the service of the last pleading directed to such issue. Such demand may be indorsed upon a pleading of the party.
>
> (c) SAME: SPECIFICATION OF ISSUES. In his demand a party may specify the issues which he wishes so tried; otherwise he shall be deemed to have demanded trial by jury for all the issues so triable. * * * *
>
> (d) WAIVER. The failure of a party to serve a demand as required by this rule and to file it as required by Rule 5(d) constitutes a waiver by him of trial by jury. A demand for trial by jury made as herein provided may not be withdrawn without the consent of the parties. * * * *

The Seventh Amendment to the United States Constitution provides:

> In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law.

Historically, the right to trial by jury has been confined to cases arising in law rather than in equity.

*Shields* v. *Thomas*, 59 U.S. 253, 262 (1855). Petitioner's case, arising under common law negligence and Federal anti-trust law, falls within the area protected by the right. The constitutional principle is well established that actions grounded in negligence are to be tried to a jury. See *Scott* v. *Neely*, 140 U.S. 106 (1891). The same is true with respect to factual issues in cases arising under the Federal anti-trust laws. See *Cherokee Laboratories, Inc.* v. *Rotary Drilling Services, Inc.*, 383 F.2d 97 (5th Cir. 1967), *cert. denied*, 390 U.S. 904 (1967); *American Tobacco Co.* v. *United States*, 147 F.2d 93 (6th Cir. 1944); *rehearing denied*, 324 U.S. 891 (1944); *affirmed*, 328 U.S. 781 (1946).

Petitioner's demand for a trial by jury was timely made. Petitioner moved for amendment of his Complaint as to the above issues on January 24, 1969, and the amendment was granted by the District Court the same day. Petitioner's motion for amended pleadings also included a demand for trial by jury. While the demand technically was not served upon the parties to the proceeding since it was filed the same day as the pre-trial conference, all parties were present when the demand was made to the Court.

Petitioner's demand for trial by jury was erroneously and unconstitutionally denied as to the aforesaid issues. After the District Court had granted Petitioner's motion to amend his Complaint as to the unlawful registration of the patent and the patent ownership, it immediately proceeded to consider Petitioner's demand for a trial by jury. The Court there stated (Tr. 140-141):

> Well, it says here that you've got to make this demand not later than 10 days after the service

> of the last pleading directing the issue to be tried by a jury.
>
> The only issue you've got here, if you are thinking about this pleading, you wanted to put some new people in that I wouldn't give you. You wanted to strike part of it, and I would let you, and you wanted to include somebody else, and they say they admit it.
>
> Motion is denied.
>
> I would like to try this with a jury and get rid of it, but if I ever tried this with a jury, I would have to set aside four weeks, wouldn't I? That wouldn't make any difference. I wouldn't mind that.
>
> Motion is denied for the same reason: it comes too late. The case has been set and it is waived.

The District Court clearly erred in its determination that Petitioner's demand for a jury trial was not timely. Petitioner's final pleading was filed the same day that his demand was made. The demand was, therefore, timely, and, accordingly, Petitioner's fundamental rights pursuant to the Seventh Amendment to the Constitution were abridged by the District Court. See *Dairy Queen* v. *Wood*, 369 U.S. 469 (1962); *Slocum* v. *New York L. Ins. Co.*, 228 U.S. 364 (1913).

2. The provisions of Rule 38(d), Federal Rules of Civil Procedure, are contrary to the Seventh Amendment to the United States Constitution. While Petitioner's demand for trial by jury was made in conformity with the time requirements of Rule 38(b), Federal Rules of Civil Procedure (Part 1, *supra*), the ruling of the District Court was to the contrary. Accordingly, if the District Court was correct, Petitioner hereby asserts that the waiver provisions of

Rule 38(d) are contrary to the Seventh Amendment to the Constitution.

It has been stated by a member of this Court that:

> The founding fathers of our government thought that trial of fact by juries rather than by judges was an essential bulwark of civil liberty. *Galloway* v. *United States*, 319 U.S. 372 (1943), dissenting opinion of Mr. Justice Black.

Petitioner submits that trial by jury—an "essential bulwark of civil liberty"—cannot be waived so lightly as the provisions of Rule 38(d) provide. Indeed, this Court itself has stated that since "the right of jury trial is fundamental, courts indulge every reasonable presumption against waiver." *Aetna Ins. Co.* v. *Kennedy*, 301 U.S. 389, 393 (1937); *Hodges* v. *Easton*, 106 U.S. 408, 412 (1882). This statement is directly contradictory with the provisions of present Rule 38, which *assume* a waiver of the right to trial by jury absent a specific demand. Acceptance of a waiver by mere silence as being constitutionally valid is starkly at odds with a constitutional requirement that "courts indulge every reasonable presumption against waiver."

Prior to adoption of the Federal Rules in 1938, waiver of the right to trial by jury could be accomplished only by an affirmative statement to that effect. See, generally, *Moore, Federal Practice* § 39.06. Silence alone was not sufficient. This rule of affirmative waiver still maintains in the Federal Rules of Criminal Procedure, Rule 23(a). If the right to jury trial is truly "fundamental", as this Court has repeatedly stated, the rules of waiver should be no different for civil procedure than for criminal procedure.

The constitutionality of a waiver by silence to the right of jury trial has never been tested in this Court. But *cf.*, ***Hammerstein*** v. ***Superior Court,*** 340 U.S. 662 (1951); ***City of Morgantown*** v. ***Royal Ins. Co.,*** 337 U.S. 254 (1949).

Petitioner submits that it is imperative for this Court to review the constitutional basis for Rule 38 (d) and to articulate—or refute—the rationale which makes the fundamental right of trial by jury something less than fundamental in civil actions. Failure to do so will perpetuate this constitutionally-unsupported inconsistency between Federal criminal and civil procedure, and will erode the right of trial by jury which the Court has continued to extend in other areas of the law. *Ross* v. *Bernard,* —— U.S. ——, 24 L.Ed. 2d 729 (1970).

3. The District Court failed to make findings of fact on a material issue—the ownership of the disputed patent. As discussed, *supra,* Petitioner amended his Complaint on January 24, 1969, to include a prayer for relief regarding ownership of the disputed patent. Upon Petitioner's motion, the following colloquy took place:

> THE COURT: * * * You want to add to that that the plaintiff is the owner of the aforesaid systems methods. I assume that is the patent.
>
> MR. CLARK [attorney for Petitioner]: Yes, sir.
>
> THE COURT: Any objection to having me declare who owns it?
>
> MR. HARNESS: No objection, your honor.
>
> THE COURT: What?
>
> MR. HARNESS: No objection on Chrysler's part.

> THE COURT: All right. Let it be amended. Now number 2, that he wants an injunction against your appropriation. I assume you wouldn't object to that if I declare he owns it. All right. The amendment—both prayers are granted. (Tr. 136)

Petitioner's Complaint was thereby amended to include the issue of patent ownership. Yet the District Court, while expressly making such ownership an issue in the case, failed to make findings of fact and conclusions of law regarding the patent ownership. These findings are expressly required by Rule 41(b), Federal Rules of Civil Procedure in a case tried to the Court without a jury. Yet on the issue of the patent, the Court ruled only that "the plaintiff totally failed to support his charge that the Defendants, General Motors Corporation and Chrysler Corporation, stole or in any manner illegally acquired the alleged invention he disclosed to his patent attorneys, Defendants Beale and Jones." (Appendix B hereto). The Court, therefore, failed to make critical findings of fact bearing upon Petitioner's rights to the subject invention and as to the ultimate ownership of the disputed patent. See, generally, *O'Brien* v. *Westinghouse Electric Corp.*, 293 F.2d 1 (3d Cir. 1961); *United States* v. *Forness*, 125 F.2d 928, 942-943 (2d Cir. 1942); *cert. denied*, 316 U.S. 694 (1942).

Failure to make findings upon a material issue or the rendering of findings of an indefinite nature are grounds for reversal. *Mayo* v. *Lakeland Highlands Canning Co.*, 309 U.S. 310 (1940); *Bateman* v. *Ford Motor Co.*, 310 F.2d 805 (3d Cir. 1962); *McClure* v. *O'Henry Tent & Awning Co.*, 184 F.2d 636 (7th Cir. 1950); *Hunter* v. *Scruggs Drug Store, Inc.*, 113 F.2d 971 (4th Cir. 1940); *United Shoe Mach. Corp.* v.

*Kamborian*, 160 F.2d 461 (1st Cir. 1947). Consequently, a writ of certiorari should issue to allow a proper review of the failure of the District Court to render such findings and conclusions as would support the decision of the Court.

## CONCLUSION

For the foregoing reasons, this Petition for a Writ of Certiorari should be granted.

Respectfully submitted,

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## APPENDIX A

[716] The Court: Well, from the evidence here, and I thoroughly understand, I do not like to hear frankly, two thirds of the case and not hear it all because I never like to have to re-digest, there is only one judge up here, in the main, so it is not the question like in some jurisdictions where I would not have to bother with it next time, somebody else would get it; the probabilities are I would have to get it back myself. Really that has no bearing on [717] it.

I am very conscious of the fact that I am duty bound to look at the evidence at the end of the plaintiff's case most favorably to him. I am fully conscious of the fact that I am supposed to draw all reasonable inferences from his evidence that would help him make out a prime facie case at that stage.

Now, if the defendants rested without putting on any evidence or after putting their evidence on, of course, the rule in the Federal Court is different. It would not be materially different here because we have no jury. I say it would not be any material difference here, however, because we have no jury.

I also know that the defendants do not have to put on any evidence unless they want to in any case. All they have to do is rely on the inability of the plaintiff to prove it.

I have looked at this evidence, first as to General Motors as carefully as I can, and all I have as to General Motors, all I have, and I know that it is available, if it could have been produced, all I have in so far as anyone in Beale & Jones Office transferring anything to General Motors is the extreme by innuendo. I could not even make it [718] innuendo. The only possibility of an innuendo is that General Motors and an office in the same downtown office building and, of course, I would be very derelict in my judgment, certainly on my duty in saying that if there was some misconduct, without finding it, that it could be inferred from office space in the same building between lawyers. I would

be going well beyond the bounds of reason, and that is the only evidence you have as to General Motors.

Now, the only other evidence that the plaintiff has produced in this Court as to General Motors, there is no evidence, none whatsoever in my opinion, that any overt acts has been proven or any overt act can be inferred that anybody in Beale's office gave or exposed anything to General Motors. Conversely, there is no evidence that General Motors agents, surreptitiously or otherwise acquired any information from these attorneys in reference to this idea.

So on the transferring it, it would have to be dismissed for want of evidence, total lacking of evidence.

As to your inference charge, that is, your contention, and you have introduced patent, the Kolbe patent, in evidence, you say the Kolbe patent reads on your idea, you say it encompasses your idea, and that at the very best it is a major coincidence that General Motors would get identi- [719] cally the same idea for handling a manifold or carburator system, or both, but limit it to the manifold, the gentleman from Lynchburg worked on, when they are not even related to each other, and that I should draw an inference from the fact that General Motors had it that they must have gotten it from you.

Well, I would be rather hesitant to draw such an inference, very frankly on that naked evidence, assuming for the sake of argument that Kolbe did incorporate identically the same idea.

The burden is on the plaintiff in this case as in all civil cases to prove his claim by the minimum of a preponderance of the evidence. And what has he offered in support of that intention except the naked patent and a couple of manifolds, one of them from Opel, which is a General Motors subsidiary, or is alleged to be, and I am accepting it, that it is, and a Dodge, I believe, manifold, which they certainly have not proven any license, or that Chrysler got whatever it got from General Motors, because there is no licensing arrangement for any showing, any connection between Chrysler and General Motors in this case.

It could be proven and the proper way to prove an idea is to get independent competent evidence. You have [720] the drawings. It is undisputed that certain drawings were given to Lockwood, certain ideas were expressed, certain ideas, the same ideas were expressed to Oliver in Lockwood's presence. Lockwood drew the series of drawings. This series of drawings were submitted not to Lockwood for approval but to Hawkins. Hawkins approved them in writing as embodying his idea. I don't think that at that time that you could possibly separate those 6 drawings on the record. It encompasses an overall idea that he was then working on. These drawings were not intended for two patents, two applications. There just is not any evidence to support two applications, that is an application for number D in the original drawings or in his. There just is no evidence to support that, that Hawkins ever intended that D be made a separate application, that is this circular picture as disclosed on D as a manifold and that they would continue on working on developing this which he characterizes as a super charged arrangement to be used in connection with the manifold. It was one overall idea, clearly.

And that is what Oliver says, and that is his witness. It was given to him. He would not have drawn it otherwise.

And there is just no evidence that Hawkins ever told Oliver or anybody when he approved them, "Well, this is [721] fine, this portrays my manifold. Now let's keep these others aside.":

It was an overall. Everybody has to be convinced of that.

Now, later and it has to be on the record as late as September 22—what is it '57, I guess it is—September '57, that is right—that he brings in a drawing which he had drawn, he says himself, by his own engineers, not by Mr. Oliver, or not by somebody by Beale & Jones, but, as I understand it—and if I am incorrect, now is the time to correct me—this number 10 was drawn by Mr. Hawkins'

engineer at his expense in Lynchburg, by nobody else. He had been experimenting with an automobile. He had it put on there. It says so from the notation on it. It is clearly a manifold situation.

And Mr. Brumbaugh writes on there "Explain to me and understood" and he gives the date, "at which time Mr. Hawkins also showed me a working embodyment, that is" that is a working embodyment of this very same drawing which he had tested on his car. I believe it was either in November or shortly thereafter he drove the car up there. So, he clearly disclosed to Mr. Brumbaugh this detailed drawing which was the heart of his idea as far as the manifold was concerned.

[722] Now, if that was identically the heart, that is hardly the same thing. Certainly they do not facially look the same as number 2—it may embody the same ideas as Oliver's D—I mean on their, generally speaking, equally spacing, and so forth, but it is not identically the same, and it has not been tested and it clearly was not ready, in fact when he brought it in at that time even by his own testimony it was not ready to have anything done with it.

Now, the evidence is vague, very frankly, there is some verbal evidence, as to why Brumbaugh, and when I use I am using Jones & Beale because he is an agent for this purpose. Then he decided to make an official search of the patent records to ascertain whether this idea, and that is the idea enclosed on 10, disclosed by exhibit 10, not the idea disclosed by exhibit 6 which includes clearly, which he admits his super charger idea along with the whole thing—Mr. Hadkins said he abandoned that later. At that time he wanted this done. Now, this search began then in 1957, and it disclosed the preliminary that it was non-patentable, and he gives him a few citations why it was, and Mr. Hawkins got the letter, because he writes back on exhibit 36, Jones 36. He got Brumbaugh' letter today, but he is puzzled. He says he does not give up easily. He says he

knows he's got something, he believes it is quite different and with results [723] that haven't been equalled.

Now, that is a fine conclusion. He says this is different from any other, and maybe these patent attorneys were wrong, maybe it could have been patented. But I do not have any evidence, except his words that it could.

How do you prove that something could be patented? There are 2 ways. One is, as Mr. Trueax says, to file it and let them turn it down.

But that is not the way you file patents. The Court only knows that from hearing patent cases. You file them—you claim the universe. I never seen one that did not claim absolutely everything under the sun in their patent. In the beginning, in the hopes that they can make it as broad as possible, and the examiner, if he runs true to form, in the file wrapper up, he starts turning it down for this one and that one and the other one, and they come back with some very adroit language, getting around all of these reasons that the patent office says that your idea is not new and novel, and it finally comes down that sometimes he's got something that they allow but it is so limited that, practically speaking, it is not worth much, and sometimes they are very effective; they get it.

But, of course, the patent cannot exceed its [724] claims and if it is not included in the claim, but we need not get into that phase of patent law.

The question here is what happened thereafter. They work on it for a while. But how long? How long did they work on it? A very short time. And although Mr. Hawkins says he does not give up easily, he did, because when they got their final report nothing further was done about it by anybody. I do not remember what the subsequent work was—Mr. Hawkins testified about it, somebody brought it out on examination, he did not think that his patent lawyers were then negligent. He did not then think they were derelict in their duties. He did not then

think that they had not given him competent legal services in attempting to get this done.

I say that because he hired them again subsequent thereto for other patent work, and I get that testimony from him without going into what it was.

And the Court has got to conclude that you do not go back to attorneys which you think were incompetent or were negligent in filing it.

Now, it is true, clearly true at the time Mr. Hawkins went back and hired Beale & Jones for other patent work that he then had no knowledge that his patent—his idea was encompassed in anybody's else's patent. He did not [725] discover this, I believe, until 1960 or something along there—I do not remember the date he discovered it—but when he discovered it he first went out, if I recall, to see Oliver—maybe I am not right on which one he went to see first, but he went to see somebody; he got the patent, he had it himself, he had it in his hand, and he takes it into Mr. Lockwood, and he jumps all over Mr. Lockwood, which I do not blame him if he thought so—oh, yes, you did. I don't blame you. I would have jumped on him, too, if I thought something was wrong with my patent, he was neglectful in it.

He went in there and talked to him about it anyway, and Mr. Lockwood was a little disturbed. He seemed to think you were accusing him of doing something with his patent and he drew some inferences.

But, anyway, he went over and searched it, he said. I believe he said he took you with him over to the Patent Office, and I believe he took your attorney with him, so he said, and they went over to—either one or the other—well, he took one or the other, it is in the record—anyway, he searched it, so he said, went into some depth, which turned out to be the Kolbe patent—I mean he went over there and looked it over—carefully, and he came back and said he told Mr. Hawkins and—he keeps pointing to you but [726] both of you are liable for each other as an attor-

ney—agent relationship—but anyway, you were told by Mr. —either through your attorney or directly that Mr. Lockwood had carefully examined the Kolbe or General Motors patent and it did not cover, in his opinion, it did not cover you idea, period. It did not read on your idea.

So you knew, at least from his standpoint—now, that may have been a self-serving declaration on his part, because you had accused him, according to him, of turning it over to General Motors, which you say you did not accuse him, but he says you did. So, therefore, he may have given you a little serving declaration that it did not read on it, but I have not heard any evidence, I have not heard a bit of evidence, and this was way back in early '60—this is '69—I have not heard of any evidence that you did anything other than accept what Lockwood told you. Clearly you did not go to any other patent attorney or any attorney, except Mr. Clark, to find out whether General Motors Kolbe patent encompassed your idea or not. Why you did not, I will never know, because if you had gone to somebody, some good patent attorney, that you had confidence in and he told you the same that would have ended this situation and saved you a lot of money and time and hurt, and everything else, if you would have [727] been satisfied that General Motors Kolbe patent did not encompass your idea because your idea was then still good if it was patentable. All you had to do was to get the other attorney to patent it or file an application for it—just that simple to me. If it did not encompass it it was still patentable. Nobody had it as far as you knew. You could have gone ahead and done it. But that was not done.

Instead what happened? There were a lot of things going on and you take it out—Mr. Clark takes it out and shows it to Oliver and Oliver comes up with some off-hand opinion. Very frankly, he said he only made a very cursory examination of Kolbe.

Well, a man cannot make a cursory examination of anything and expect his opinion to be accepted on that subject

matter. He certainly did not say he went down to the patent office and looked at it. To the contrary—and the file wrapper is the very heart of the patent, it tells everything that is in it—he just looked at the printed patent. That does not include the file wrapper at all. I mean that is the drawing and the claim is about all that is on those printed forms.

And then they have been proceeding from then on to prove that somebody stole your idea and it has all been by [728] inferences.

Now, I wanted to give you a full hearing, Mr. Hawkins, even though I frankly would have to say that your claim in the manner and form it was written was vague and indefinite and we tried to get it pinned down as much as possible to give you every opportunity to prove that you had any knowledge of any sculduggery—you did not like to use the words stealings; I used it for you—I said it is stealing if they got it in the manner in which you said they got it because I wanted to give you every opportunity.

Very frankly, you just have not proven it and I am not particularly so friendly with General Motors that I would indicate that you had not proved it, because if I thought you had, I do not even want any of their stock, so I haven't anything for them or against them because they are the biggest corporation. I just do not think you can charge a corporation and make it stick without a scintilla of evidence.

Now, we get back to the second question—so the suit as to General Motors will be dismissed for lack of evidence. I would have to set it aside if it was a jury. We do not have a jury here. So I could not give you a judgment, and I am the one that would have to make the findings [729] in your favor if they sit still. So I cannot assume that your case would be better by letting them take the stand and go ahead and deny everything, and so forth, because you called Lockwood. You had a right to call them all. You had his whole story. You are bound by the part of it that is not incredible. You called Kole.

Now, we get back to the lawyers and that is on this negligence basis.

I understand the law to be that malpractice or negligence in so far as a lawyer is concerned is no different than it is to a doctor or anybody else. Reduced to simplicity it is 'the failure to do what a reasonable prudent person would do under the same or identical circumstances, and in case of an expert or skilled person, as a lawyer is, and as a patent attorney, which is a more skilled as a lawyer in that specialty, he is required to exercise that degree of care that an ordinary prudent skilled patent attorney in that jurisdiction exercises. If he does that, if his opinions are wrong, he is just not liable any more than a doctor is liable if he uses that degree of skill that I just enunciated because the patient dies.

Now, what is the evidence of negligence? In the first place we have no standard by which to judge this case and that burden is on the plaintiff, clearly. In a [730] negligence suit, the burden is on the plaintiff to establish what the standard is in this community and he has not done it.

But being a lawyer, I think I could take judicial notice of it, but it takes more than that. He has not produced a single lawyer or patent attorney to state what is the customary standard practice that reputable, skilled patent attorneys do when an inventor comes in with an idea. If he had produced the standard, I could have measured clearly what the people did do or what they did not do, to to see whether it met that test or that standard.

But you just do not produce any.

But even going ahead and analyzing what they did not do and what they did do, I really do not go too much by the fine print on what lawyers write on receipts and what they write on retainer contracts because if they write one they usually write a self-serving declaration. I could not hate them for not. That may be one reason why I never used a retainer agreement or anything of that kind. Sometimes it hurt me more than it did the other fellow.

I agreed to do a whole lot more than I wanted to do for what I agreed to take. So we tried to work on it later.

So, the facts that Mr. Lockwood did not on his breakdown bill say expressly that this does not include a [731] search does not mean much to me. He could have charged—the man came in and clearly wanted to get this idea investigated and patented. And there is not much doubt that he told Mr. Lockwood that it was quite a hot idea, it was new, and so forth, and he knew that it was real good and he wanted it protected; and I mean by protected—that may be another word—that he wanted to get it done. I do not know whether he did or did not—I do not know whether it makes any difference—whether he said, "I expressly do not want it searched; file it today"—you do not talk to lawyers that way. But certain things have to be done. Mr. Lockwood thought enough of it on the first interview with a stranger to call a draftsman in, and they explained it and they worked it out.

Now, why after they had all those things approved, they did not start in on the specifications and on the claims and on the other things that were incidental—I mean to the filing of an application, frankly the evidence is a little vague. They just say it was not ready.

Now, the next thing comes along and Mr. Lockwood writes and tells him—I do not know why he wrote him, but he did write and tell him, that he was going to take his up in order. I do not know whether he was pressing him or whether he was not. But he certainly knew when he wrote and told him [732] that he was going to take it up in order; it would be some little time before he could get to it. Mr. Hawkins did not make any complaint about that. He must have acquiesced in it because he got the letter. He did not write and say, "Look, I don't want you if you can't handle it. Let me go get somebody else." He did not do anything.

And it is then turned over to Mr. Brumbaugh.

Well, of course, they are liable for Mr. Brumbaugh.

They go ahead and get into an awful lot of work on it. He clearly was working on this overall idea. Clearly he was working on it. He was making all kinds of tests with his own engineers and his own experimental and a few other things, drawings, and there was considerable correspondence, and he did say he was busy. He did not say he was busy on this. Mr. King did. But I just understood him he was busy but he did not get around to doing it but they did get to it, and he comes up again on September 27th, and it would appear to the Court from this record that that is when he has something finalized that everybody indicated we ought to go ahead with, and that is when they began the search, and that is when they found that it was not patentable and told him so.

Now, they could have been wrong in that. I do [733] not think it is any duty on a patent attorney—it may be—but I have never heard any law to this effect—nobody ever quoted it. I take an idea to a patent attorney—that they've got to go ahead and file an application if they are satisfied it is not patentable. I mean, really, I do not know that there is any law that says they have to do that for any reason. They are paid to give professional advice as I would understand it, whether this idea is patentable or not. It is debatable. They may or may not. Anyway they did search it, so it is moot and they got it searched, but they never filed it. He said he didn't give up easy. I have not heard of any evidence, and he was a prolific letter writer, to a certain extent, in long hand, after he was told that the search was not good, I have not heard a bit of evidence from Mr. Hawkins or a lettter that says, "Well, even though your orekununbart examination indicates that it is not patentable, I am willing to pay the bill. Let's go ahead and spend a couple hundred dollars and file it and see what the commissioner says about it."

I did not hear any evidence to that, that he insisted that they file it anyway, and they refused to file it. Now, clearly, they did not file it and they did not file it because they said

they didn't think it ought to be [734] filed on this ground, and I am not saying that he had not paid them. They did an awful lot of work for $457.00, it appeared to me like, in this case, but that is their business. They can do it for free. The mere fact they did not get the money—I mean they never asked him for any more money either that he turned down, so the failure to pay has nothing to do with their—the only reason they did not file is because they said it was not new and novel, it was not patentable in their opinion. He forgot it. At that time he knew nothing about General Motors.

Where do we go next on their case?

Now, if they are negligent, and frankly, really, in the absence of a standard, I could not find them negligent on that set of facts, but if I did find them negligent, it takes actionable negligence just like this Tort Case we have now. Negligence alone never made anybody liable. It is actionable negligence that makes a man liable, and in actionable negligence, there must be some damage proximately flowing from the negligence.

Now, the negligence, if there was negligence on their part, which I do not find, would be their negligence in the delay in the searching, number one, and not having s[illegible]ched and found it out sooner.

[735] Well, if the search would have disclosed the same thing a year earlier, the plaintiff would have been in the same fix he is in now. He would have had a piece of legal information that says his idea was not patentable and it would have saved him the time and money for all the subsequent engineering, and that is all it would have done because they had him going on, so he does not claim those damages—I mean that is not what he is asking.

But the other act of negligence would be in the failure to file after they have an opinion.

I have no hesitancy in saying I never filed a suit in my life, and I filed many of them and all kinds, that I honestly felt I did not have a case at law. I just do not think good

lawyers do that, whether it be General Motors or anybody else.

So why should I go ahead and file it if I—I could be wrong, clearly I can—but just like Mr. Trueax said it turned out that he lost $17,000.00 case because he did not think there was liability. Well, he was wrong, but that does not make him liable for it.

And it does not make these lawyers any more liable. They did not file this application because they did not think it was fileable with propriety and they do not go [736] around and file things with the Patent Office that are summarily rejected. It hurts a lawyer's reputation, among other things.

That could not be negligence.

But, as I say, even if there is negligence, if there was negligence, there must be damages.

Now, there is not anybody satisfied me that this carburetor idea, number one, is patentable.

If you do not want to accept Beale's opinion—I mean Lockwood's, which could be self-serving, but at the time it was made, because at the time that was made he knew of General Motors, and he knew he had been accused of turning the idea over to them because he said so, so we will say his was a little self-serving, but there is no duty on them, me in 5 other patent lawyers to show that this idea was never patentable from the time he brought it in because it was not new and novel and because it was fully known in the art. He has not brought me anybody to show me that it was.

I cannot read Kolbe's claim patent against this patent because he does not have one. He does not even file a claim. I don't know whether he even claims the same thing that Kolbe claims and there is nothing to read it against as [737] far as I am concerned other than the nebulous idea and I did not have it but I do have Mr. Kolbe himself, who I will say is very experienced, regardless of what Mr. Frost said. Nobody has told me that he did not tell me the truth that he told me on the stand

that he was the design engineer for all of Chevrolet engines, I believe he said '37, but whatever year was, early 30's, until he retired in the 60's, and if he was the chief design engineer for all Chevrolet engines I've got to say he was quite experienced. They put an awful lot of engines on the road over a period of years and you acquire experience by two sources. One by getting a college degree—you are alleged to be right informed. If you are good enough to do what he says he has been doing for all these years he does not need a college degree. He has proven that he knows what he is talking about.

Now, I do not say that because I think people ought not to get college degrees, but that is not the lone criterion because he does not have an engineering degree, and his relationship with the now-hyphen president did not have anything to do with that either.

But he clearly says that this idea was known to him in the engineering business all his life, it was known in England, anybody that ever worked on an internal combustion [738] engine knew about it, so he says, well known in the art. He said he dabbled around with this idea himself in the method by which he distributes his gas or whatever he calls it, and I am not getting technical now, and I do not want to be held to it, but he says they abandoned it in Chevrolet in '55, they abandoned it because the idea would not work on this manifold the way he understands this picture to portray which he says was not patentable then. He said Chevrolet is not using it then and not using it now.

He said his combination patent has to do with parallel of the pipes something in there, it is a combination, as I understand it to be.

Be that as it may, the plaintiff's own testimony says it is the same. Now they are bound by Kolbe's testimony. They did not put him as an adverse witness. Even if they had and I might have allowed it, they would still be bound by his testimony because you are bound by adverse testimony that is not contradicted or is not in issue

Nobody has questioned what he said.

So I would have to find even if there was negligence in this case that there was no actionable negligence.

For the reasons stated the complaint against the attorneys is dismissed.

[739] You can note your appeal as to all of them at the same time.

Sorry that I could not be more satisfactory to everybody but it is just the way you have to do these things.

Yes, sir.

• • • • • • • • • •

## APPENDIX B

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
ALEXANDRIA DIVISION

**Civil Action No. 4549**

ST. ELMO HAWKINS, *Plaintiff*

v.

GENERAL MOTORS CORPORATION, ET AL., *Defendants*

### Supplemental Findings and Conclusions

General Motors Corporation has submitted proposed supplemental findings and conclusions to those made by the Court at the conclusion of the plaintiff's case. The Chrysler Corporation joins General Motors in its request —the defendant Jones is satisfied with the findings orally made by the Court. The plaintiff objects to many of General Motors' proposed supplemental findings but proposes none of his own. All of the parties have asked the Court to dispose of the matter without further argument in order to expedite the appeal.

Upon reviewing the Court's comments made during and at the conclusion of the arguments following the plaintiff's case, for the sake of brevity and clarity:

The Court finds that the plaintiff totally failed to support his charge that the defendants, General Motors Corporation and Chrysler Corporation, stole or in any manner illegally acquired the alleged invention he disclosed to his patent attorneys, defendants Beale and Jones. The plaintiff proved that he took his idea to Beale and Jones on April 20, 1956 and paid them a fee in re patenting his alleged invention. He also proved that he had numerous conferences with his patent attorneys, and that drawings were made and submitted and that he was finally advised by his patent attorneys that his alleged invention was

not patentable. He produced no evidence whatsoever that his idea was transmitted to General Motors or the Chrysler Corporation by word of mouth or otherwise. All he proved was that a partner of Beale and Jones was acquainted with an attorney in the General Motors Patent Section offices and that this partner may have introduced the free-lance draftsman, who made some of the drawings, to this attorney. He also proved that this free-lance draftsman had done some drafting work for General Motors prior to April 20, 1956.

It was admitted that Beale and Jones occupied adjacent offices to those occupied by General Motors Corporation Patent Section for three years and that they moved in July of 1956 to another location in which General Motors Acceptance Corporation had offices. It was also shown that the General Motors Corporation Patent Section took over some of the former office space which Beale and Jones had occupied and that General Motors purchased some carpeting from these patent attorneys.

The plaintiff further proved that General Motors obtained two patents, one, April 21, 1959, and one, February 6, 1962, on the alleged inventions of one, A. E. Kolbe.

Kolbe was called by the plaintiff. He testified that he originated the inlet manifold construction, as set forth in the 1959 General Motors patent, in 1954. He said it was built and tested by the Chevrolet Division of General Motors in 1955.

The plaintiff claims that his idea was incorporated in the Kolbe patent and in Chrysler Patent No. 3,109,416. However, he produced no expert testimony to support this contention. To the contrary, the evidence disclosed that he took the Kolbe patent to his patent attorneys, Beale and Jones, and that they advised him that "Kolbe's claim cannot be read on your disclosure."

Further, the plaintiff's evidence failed to disclose any licensing arrangement or any connection between General Motors and Chrysler relating to intake manifolds.

Although the plaintiff has failed to produce any evidence to support his claim that his patent attorneys disclosed the ideas behind his alleged invention to General Motors or Chrysler, he nevertheless claims the patent attorneys are liable for his losses due to their negligence in failing to timely search the patent records covering his idea and in failing to file a protective suit after they learned that General Motors had received a patent encompassing his idea.

The plaintiff satisfied the Court that he had retained Beale and Jones to search the patent records and to do what was necessary in order to file an application for a patent on his invention if they determined it was patentable.

He has also shown the Court that these patent attorneys were somewhat dilatory in completing the work for which they were retained, even though much of the delay was occasioned by the plaintiff's failure to furnish them with the necessary information.

Although delay in performing legal work may under some circumstances be negligence—although the Court does not here find there was negligence—it takes more than negligence to support a recovery.

Beale and Jones, upon the completion of their work, determined that the plaintiff's idea was not patentable. They so advised him some time prior to the date of the Kolbe patent. The plaintiff was then apparently satisfied because he thereafter took other work to these same patent attorneys. He now says that the patent attorneys should have filed his application with the Patent Office even though they were of the opinion that his idea was not patentable. An attorney is not liable for not filing a suit in a case where he thinks there is no basis for filing such a suit. Neither is

a patent attorney liable for refusing to file an application for a patent in a case where he thinks the idea or the invention is not patentable. The plaintiff does not here claim that he paid or requested the patent attorneys to file his application after he was told that his invention was not patentable.

The plaintiff's claim that Beale and Jones are liable for not filing a protective suit after they learned of the Kolbe patent is equally lacking in evidentiary support.

The plaintiff's case, upon motion of the respective defendants, was dismissed at the conclusion of his case solely because he failed to produce sufficient evidence to prima facie establish any of his claims.

The Clerk will send copies of these supplemental findings and conclusions to all counsel of record.

/s/ OREN R. LEWIS
*United States District Judge*

August 7, 1969

## APPENDIX C

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

No. 13,955

ST. ELMO HAWKINS, *Appellant*,

v.

GENERAL MOTORS CORPORATION, CHRYSLER MOTORS CORPORATION, and GEORGE R. JONES, T/A BEALE AND JONES, *Appellees*.

Appeal from the United States District Court for the Eastern District of Virginia, at Alexandria. Oren R. Lewis, District Judge.

(Argued April 9, 1970 Decided May 21, 1970)

Before SOBELOFF, BRYAN and CRAVEN, *Circuit Judges*.

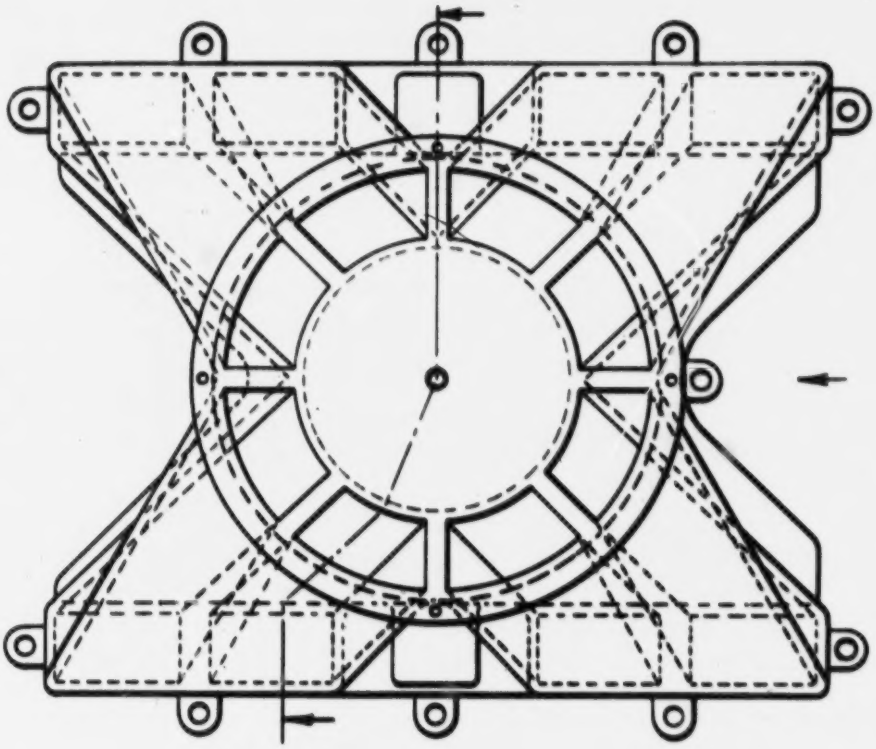
John Douglas Clark and Alfred W. Trueax for Appellant; Preston C. King, Jr., (John T. Hazel, Jr., and James C. Gregg on brief) for Appellee George R. Jones; and Warren E. Finken (George E. Frost, William A. Schuetz, Charles R. Engle, William R. Perlik, and Wilmer, Cutler & Pickering on brief) for Appellee General Motors Corporation; and Don K. Harness (Harness, Dickey & Pierce; William A. Moncure and Richard, Moncure & Whitehead on brief) for Appellee Chrysler Motors Corporation.

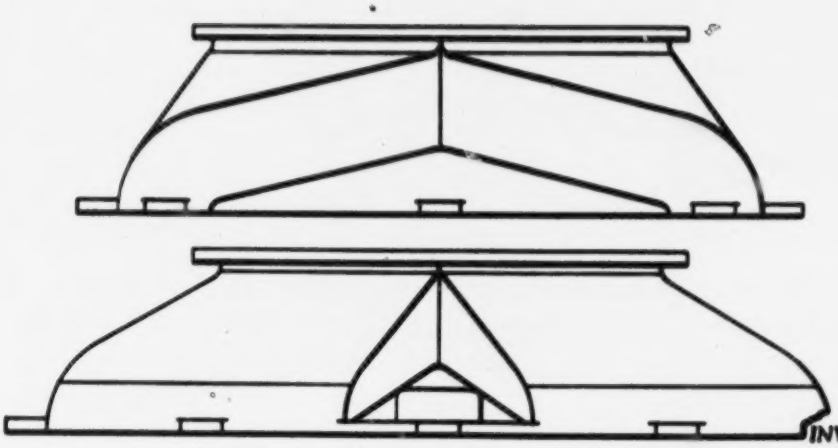
PER CURIAM:

St. Elmo Hawkins has sued his former patent attorney, General Motors Corporation and Chrysler Corporation for misappropriation of an invention. The trial judge afforded plaintiff every opportunity to prove his allegations, but Hawkins was able to demonstrate neither the existence of a conspiracy nor actionable negligence on the part of the attorney. Finding no error in the District Court's disposition of this case, the judgment is

*Affirmed.*

APPENDIX D





INVENTOR

St. Elmo Hawkins

BY Beale & Jones

ATTORNEYS

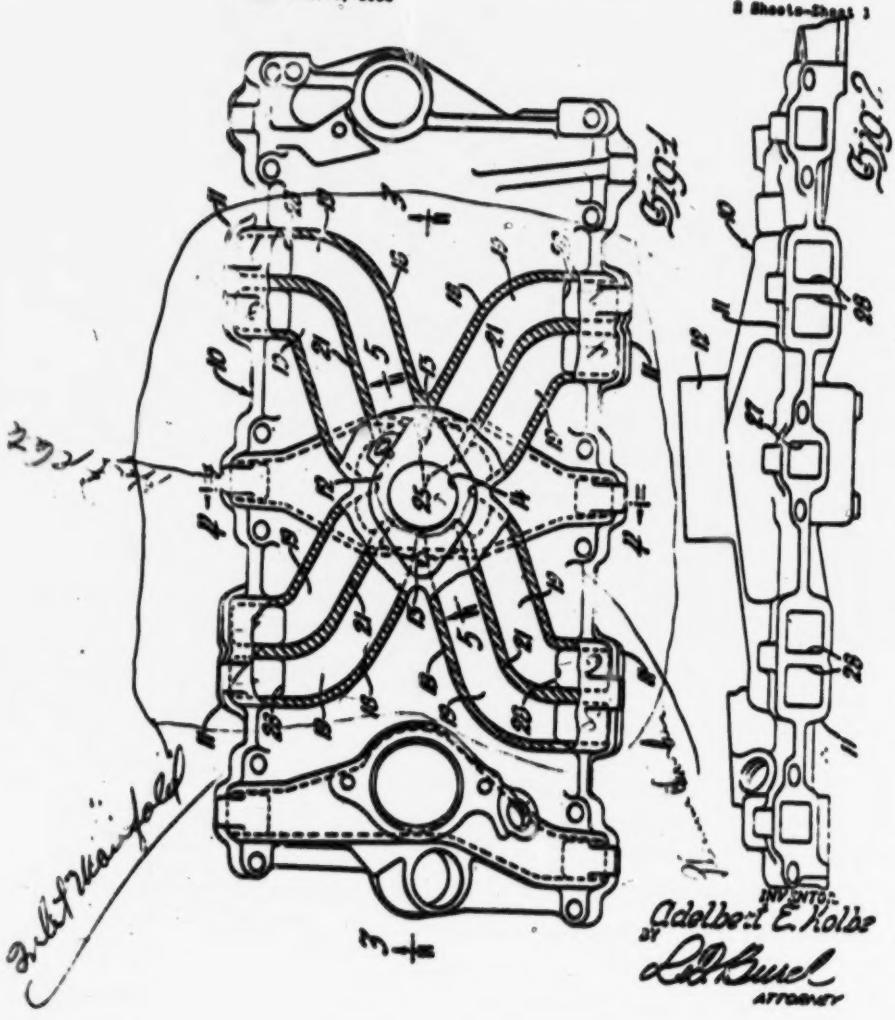
# APPENDIX E

C/A 4,574-9
GM Exhibit 49A
FEB 17 1960

April 21, 1959 A. E. KOLBE 2,882,875

Filed Dec. 6, 1956 INLET MANIFOLD

2 Sheets-Sheet 1




INVENTOR.
Adelbert E. Kolbe
BY
L. L. Buell
ATTORNEY

## APPENDIX F

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA

Civil Action No. 4549

ST. ELMO HAWKINS, *Plaintiff*,

v.

GENERAL MOTORS CORPORATION,
CHRYSLER MOTORS CORPORATION,

and

GEORGE R. JONES t/a BEALE AND JONES, *Defendants*.

**Motion To Amend Amended Pleadings**

Comes now plaintiff and moves the Court for permission to amend complaint to incorporate certain parts of the original complaint, add additional parties, and to request additional relief.

1. Plaintiff moves for leave to join Edward B. Beale and Harris C. Lockwood with defendant George R. Jones t/a Beale and Jones, 425 13th Street N.W., Washington, D. C. as defendants.

2. On page 1, paragraph 2, jurisdiction is also founded on diversity of citizenship and amount in controversy. USC Title 28, Section 1332.

3. On page 2 amend by adding the following after paragraph (d):

(e) The defendant, Edward B. Beale is a citizen of the State of Maryland, and is engaged in the practice of law in the District of Columbia and in Virginia, as patent attorney.

(f) Defendant, Harris C. Lockwood, is a citizen of the State of Maryland, and is engaged in the practice

of law in the District of Columbia and State of Virginia, as patent attorney.

(g) That the foregoing described individual defendants are engaged in the business of the practice of patent law in the District of Columbia, under the firm's name of "Beale and Jones," with offices in the Pennsylvania Building at 425 13th Street, N.W., in said District.

4. Amendment, Defendant George R. Jones where shown to Defendants Edward B. Beale, George R. Jones and Harris C. Lockwood t/a as Beale and Jones.

5. Amend paragraph 21, page 11 to read: Plaintiff further alleges that his investigations further disclosed that Chrysler Motors Corporation in 1960 secured a patent with the same idea as General Motors Patent 2,882,875 and No. 3,019,781 and the invention of Plaintiff.

6. Add to pages 12, 16 and 19, demands on count one, two and three to wherever plaintiff prays for (1) a declaration that plaintiff is the owner of the aforesaid systems, methods and invention and (2) an injunction against appropriation or utilization thereof by defendant.

7. Page 17, eliminate second paragraph.

8. Plaintiff demands a jury trial.

Respectfully submitted,

/s/ JOHN D. CLARK
*Attorney for Plaintiff*

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SUPREME COURT, U. S.

FILED
JAN 19 1970

IN THE

# Supreme Court of the United States

OCTOBER TERM, 1970

No. 873

ST. ELMO HAWKINS,

*Petitioner,*

v.

GENERAL MOTORS CORPORATION, GEORGE R. JONES, AND CHRYSLER MOTORS CORPORATION,

*Respondents.*

## REPLY OF RESPONDENT GEORGE R. JONES TO PETITION FOR WRIT OF CERTIORARI

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*Counsel for Respondent Jones*

Washington, D. C. · [illegible]

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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1970

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No. 873

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ST. ELMO HAWKINS,

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GENERAL MOTORS CORPORATION, GEORGE R. JONES, AND CHRYSLER MOTORS CORPORATION,

*Respondents.*

---

## REPLY OF RESPONDENT GEORGE R. JONES TO PETITION FOR WRIT OF CERTIORARI

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### STATEMENT

On August 1, 1967, petitioner filed his complaint in the United States District Court for the Eastern District of Virginia against the three respondents herein. He alleged that his original idea for a patent which he disclosed to respondent Jones' partner and associate as his patent attorneys was fraudulently or negligently disclosed by them to respondents General Motors and Chrysler Corporation. As a result of this alleged fraudulent conspiracy, petitioner claimed respondent General Motors obtained two patents

encompassing his idea. As petitioner and respondent Jones are both residents of the Commonwealth of Virginia, a motion was filed by respondent Jones to dismiss on the ground of lack of diversity of citizenship. Petitioner then on October 18, 1967, amended his complaint invoking the jurisdiction of the District Court under the Sherman, Clayton and related acts alleging that the respondents had fraudulently engaged in a series of conspiracies to defraud people of inventions which acts substantially affected interstate commerce adversely and resulted in the loss of petitioner's alleged invention.

All respondents filed answers and voluminous depositions were taken over an extended period of time. Finally the case came on for pretrial on January 24, 1969, approximately one and a half years after the original complaint was filed and fifteen months after the filing of the amended complaint. At that time petitioner submitted a motion, copy of which is set forth in Appendix F to petitioner's brief (page 23a). It sought to join as parties other partners of the firm of Beale and Jones, to have the amended complaint state that petitioner was the owner of the alleged invention in question, and that he sought an injunction agianst its appropriation and utilization. In the same motion for the first time, petitioner demanded a jury trial. The court without objection permitted the petitioner to claim ownership of the alleged invention which was already the basis of his claim and to seek an injunction but denied the demand for a jury trial. Petitioner's motion was not filed or served as required by Rule 38 of the Federal Rules of Civil Procedure. It was in effect simply a motion to conform the pleadings to the proposed evidence, a fairly common tactic at pretrial. The trial began on February 17, 1969, and concluded on February 19, 1969, when the district judge dismissed the amended complaint at the conclusion of petitioner's case on the ground that no proof of conspiracy, fraud or negligence was introduced (App. Pet. Brief, p. 1a to 19a).

Appeal was taken to the United States Court of Appeals for the Fourth Circuit, which upheld the District Court's

ruling in a decision reported in 427 F.2d, 148, copy of which is included in appendix to petitioner's petition, page 20a. The questions raised here by petitioner as ground for this Court's issuance of the writ were not raised, briefed or orally argued in the presentation before the Fourth Circuit.

At the trial in the District Court, petitioner abandoned the theory of his amended complaint, filed in October, 1967, that the respondents had engaged in a series of conspiracies in violation of the anti-trust acts. He narrowed his presentation in an attempt to establish that respondent Jones' partner and associate negligently or fraudulently disclosed the confidential information concerning petitioner's alleged invention to respondent General Motors Corporation and Chrysler Motors Corporation, enabling them to secure two patents from the United States Patent Office. The difficulty with petitioner's presentation, however, was that the witnesses whom he called denied the existence of any fraud, negligence, or conspiracy and affirmatively testified that petitioner's idea for his alleged invention did not read on either of the patents obtained by respondent General Motors. Indeed the undisputed proof showed that petitioner did not finalize his alleged idea that he originally submitted in April, 1956, to respondent Jones' partner and associate until September 27, 1957, on which date he presented the final drawing of his alleged invention (Vol. IV, Jones Ex. 10, Vol. XIII, p. 568, original record Ct. of App.). The application for the patent about which petitioner is complaining the loudest was filed by respondent General Motors Corporation on December 6, 1956 (Pet. Brief, p. 3), so it would have been physically impossible for respondent Jones' partner or associate to have transmitted any information of any kind to the other respondents concerning petitioner's alleged invention.

## ARGUMENT

### THE WRIT SHOULD NOT BE GRANTED

### There Exists No Special or Important Reasons For the Issuance of the Writ

The case below was decided by the Federal District Court for the Eastern District of Virginia and there is, therefore, no question of a state court deciding a federal matter. There is no conflict among the decisions of the federal circuit courts of appeals. There is no important federal question which has not been decided nor has a federal question been decided in conflict with applicable decisions of this court, nor has there been a departure from the accepted and usual course of judicial proceedings.

### The Right to a Jury Trial May Be Waived

The cases make it abundantly clear that the Seventh Amendment to the Constitution did not create a right to a jury trial but merely preserved the rights existing at common law at the time of the adoption of the Constitution. Hence, such right is not jurisdictional in nature and may be waived. See *Kearney v. Case*, 12 Wall 275, 281, 79 U.S. 275; *General Tire and Rubber Company v. Honorable R. Dorsey Watkins*, 331 F.2d 192 (cert. denied 377 U.S. 952); *American Manufacturers Mutual Insurance Company v. American Broadcasting-Paramount Theatres, Inc.*, 45 FRD 38.

### The District Court Properly Exercised Its Discretion In Refusing To Grant Jury Trial

The original complaint was filed August 1, 1967, and an amended complaint October 18, 1967. Answers were timely filed by all respondents. Demand for a jury trial was not made until the pretrial hearing on January 24, 1969, approximately one and a half years after the proceedings were instituted, and fifteen months after filing the amended

complaint and less than a month before trial and long after any documents described as pleadings in Rule 7 of the Federal Rules of Civil Procedure had been filed. Petitioner's request at pretrial was simply one to conform the pleadings to his expected proof. The theory of the proceedings was in no way changed (See Sec. 873, Vol. 2B, Barron & Holtzoff, Fed. Prac. and Procedure, p. 35, 36; Moores Federal Practice, 1969 Ed. Vol. 5, Sec. 38-39 p. 318, Sec. 38-41, p. 329). Petitioner wanted to express what was inherent in his amended complaint, namely that he was the owner of the alleged invention and that he wanted to prevent its appropriation by anyone else. Both of these requests which the Court granted were simply matters of clarification and were inherently a part of the original and amended pleadings of the petitioner. No additional pleading was filed by petitioner as a result of granting his motion. Courts generally will permit the parties at any time during the course of the trial to conform the pleadings to the facts. If this type of action was to be considered a pleading within the terms of Rule 7 of the Federal Rules of Civil Procedure there never would be a final determination as to the question of waiver of a jury trial and Rule 38 would be superfluous.

Petitioner's position that findings of fact regarding the ownership of his alleged invention were necessary and not made by the District Judge is simply incorrect. The District Court found (Pet. Brief p. 10) that petitioner failed to support his charge that respondents stole or illegally acquired his alleged invention. Thus assuming ownership by petitioner of his idea the court said it was not acquired or disclosed by any of respondents.

**Petitioner Failed To Raise the Jury Trial Question in the Circuit Court**

Petitioner failed, either in his main or reply briefs in the Fourth Circuit Court of Appeals or in oral argument before that court, to raise the jury trial point. Thus, it is clear that he intended to abandon his point and did not think it of much substance.

**Petitioner Was Not Harmed by the Denial of His Request for Jury Trial in the District Court**

The District Judge after a very full hearing at which not only numerous witnesses testified but voluminous depositions were introduced determined as his excellent analytical opinion demonstrates that there was absolutely no proof of any conspiracy or negligence. The Fourth Circuit Court of Appeals in its opinion after an examination of briefs and the record stated at 427 F.2d 148:

> "The trial judge afforded plaintiff every opportunity to prove his allegations but Hawkins was able to demonstrate neither the existence of a conspiracy nor actionable negligence on the part of the attorney." (App. C, P. 20a, Petitioner's brief)

## CONCLUSION

For the foregoing reasons it is respectfully submitted that the petition for writ of certiorari should not be granted and the writ should not issue.

Respectfully submitted,

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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1970

No. 573

ST. ELMO HAWKINS,
Petitioner,
vs.

GENERAL MOTORS CORPORATION, GEORGE R. JONES, t/a BEALE AND JONES, and CHRYSLER MOTORS CORPORATION,
Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

# BRIEF FOR RESPONDENT CHRYSLER MOTORS CORPORATION IN OPPOSITION

## Counterstatement of the Case

Petitioner Hawkins sued Respondents General Motors Corporation, the law firm of Beale & Jones and Chrysler Motors Corporation in the District Court for stealing Petitioner's alleged invention, which he had taken to the law

firm of Beale & Jones in 1956 for evaluation of its patentability. Beale & Jones' opinion was that the invention was not patentable.

In 1960 Petitioner discovered a U. S. patent which issued to General Motors on an engine manifold which he thought looked like the manifold design he had taken to Beale & Jones. He also learned that the General Motors patent staff had occupied office space next to the Beale & Jones' offices in 1956. Based on this happenstance casual connection of next door office space, Petitioner attempted to prove in the District Court that General Motors had stolen his invention and that Beale & Jones was negligent in not filing a patent application on Petitioner's invention.

Regarding Chrysler, the Petitioner noticed in 1965, manifolds on Chrysler cars which he thought looked like his manifold design. Later, he learned that Chrysler had obtained a patent on its manifold. From this he deduced that Chrysler was in collusion with General Motors and that his invention had in some manner been traded off or passed on to Chrysler. Thus he also asserted during District Court proceedings that General Motors and Chrysler had engaged in conspiracy in violation of antitrust laws.

Petitioner did not call an expert during the trial in the District Court who could have explained whether the General Motors or Chrysler patents actually covered Petitioner's alleged invention, instead he offered testimony on this point from a draftsman who had prepared his original patent drawings at Beale & Jones and who admittedly had not even studied the claims of the patents.

The District Court, by oral and written findings of fact, found that Petitioner "totally failed" to support his charge that Chrysler or General Motors stole or in any way illegally acquired his alleged invention and, that he had produced

no evidence whatsoever that his alleged invention was transmitted to General Motors or Chrysler by word of mouth or otherwise. The District Court dismissed Petitioner's action after he had rested his case for failure to establish any *prima facie* case. (Petition, App. A and B.)

## Argument

No question of law or justice denied presents itself in this case which is worthy of review by this Court. Nothing is presented in the way of variance between circuits or importance in constitutional law. It is just a standard ordinary case where the District Court dismissed the action because of total lack of evidence to support the charges.

Affirmance by a short *per curiam* decision was the ruling of the Court of Appeals for the Fourth Circuit, with a statement that the trial judge had afforded Petitioner "every opportunity to prove his allegations" but that he was unable to do so. (Petition, p. 20a.)

### Question No. 1.

Denial of right to jury trial is the first matter asserted by Petitioner as requiring review. It is settled law that any right to jury trial is waived where no demand for same has been made as required by Rule 38, Federal Rules of Civil Procedure. *United States v. Moore*, 340 U.S. 616 (1951). *Wilson v. Corning Glass Works*, 195 F. 2d 825 (9th Cir., 1952). *Roth v. Hyer*, 142 F. 2d 227 (5th Cir., 1944); cert. denied 323 U.S. 712.

Petitioner started his action against Respondents in August, 1957 and on numerous occasions thereafter he had opportunity to demand a jury trial, however, by not timely doing so pursuant to Rule 38(b) any right to jury trial was waived.

On January 24, 1969, approximately 1½ years after bringing suit, and less than a month before the trial began, Petitioner moved to amend his already amended pleadings and at the same time requested a jury trial. The District Court permitted certain of the amendments, but denied the request for jury trial as coming too late under Rule 38(b) and as being waived under Rule 38(d).

Chrysler submits that since there was no abuse of discretion by the District Court ". . . the right to a jury trial, when once waived, cannot be revived, by a belated amendment of pleadings touching the same general issues." *Moore v. United States*, 196 F. 2d 906, 908 (5th Cir., 1952). *Connecticut General Life Insur. Co. v. Breslin*, 332 F. 2d 928 (5th Cir., 1964).

Yet even if the three amendments to the pleadings which were permitted (Petition p. 4) by the District Court less than a month before trial began are considered as the "last pleading" intended in Rule 38(b) to initiate the 10 day response period for demanding a jury, still the prayed for relief sought in these pleadings was *in equity* and thus these pleadings would not constitute an "issue triable of right by a jury . . ." as Rule 38(b) requires. *Moore's Federal Practice*, Sect. 38.41, at page 327 states:

> To renew the right to demand a jury trial, the amendment must convert a "suit in equity" into an "action at law," or otherwise create new jury issues. This was well stated by Judge Rodney in *Reeves v. Pennsylvania R. Co.*:
>
> "The authorities are uniform that when a plaintiff has waived a jury trial and subsequently files an amendment to the complaint which does not change the nature of the case or introduce new issues, such amendment does not entitle the plaintiff to demand a jury trial as a matter of right

and over objection, pursuant to Rule 38(b)." *Reeves v. Penn. R. Co.*, 9 F.R.D. 487 (D Del. 1949).

At best this Court's review of whether the three pleading amendments formed sound basis for demanding a jury trial would be a moot exercise. While Petitioner submitted no actual evidence to show that General Motors stole his invention, and based his case against General Motors and Beale & Jones on the circumstance that they had adjoining offices, there was not even a scintilla of evidence to show that Chrysler illegally secured any information regarding manifolds or its patent from General Motors or Beale & Jones, or that Chrysler's patent even covered the same idea as Petitioner's alleged invention. The District Court even stated (Petition p. 8a) that due to lack of evidence any contrary jury verdict, had there been a jury, would have been set aside.

Lastly Petitioner could have, but did not, request a jury trial by motion under Rule 39(b) after the District Court had ruled the jury demand came too late under Rule 38.

**Question No. 2.**

Petitioner also asks review stating that Rule 38(d) concerning waiver by silence of trial by jury is unconstitutional and contrary to the Seventh Amendment.

This Court has long held that neither the Sixth nor the Seventh Amendments are jurisdictional in nature and hence that the right of jury trial may be waived. *Kearney v. Case*, 12 Wall 275 (1870); *United States v. Moore*, 340 U.S. 616 (1951); *Moore's Federal Practice*, Sect. 38.05[5].

Rule 38, subparagraphs (a)-(d) inclusive, is unchanged since 1937. In regard to waiver of jury *Moore's Federal Practice*, Sect. 38.43, page 336 states:

Provisions for waiver of jury in federal practice go back as far as 1865. And although the pre-Rules practice required an express waiver, while Rule 38 proceeds on the very different theory of an automatic waiver in the absence of a timely affirmative demand, the integrated provisions of Rules 38 and 39 deal with jury and court trials in an effective and reasonable manner. As the Court observed in *City of Morgantown, W. Va. v. Royal Ins. Co.* [337 U.S. 254, 258 (1949)] concerning the method of trial under the united practice:

> "with careful regard for the constitutional rights of the parties, this Court, pursuant to specific authorization by Congress, adopted the Rules of Civil Procedure, abolishing procedural distinctions between law and equity and establishing a single unified practice."

This Court has also dealt with waiver by silence or inaction in *United States v. Moore, supra* page 621 as follows:

> Respondents also contend that the trial of this proceeding as an action for equitable relief denied their constitutional right to a jury trial. No demand for a jury trial was made as required by Federal Rule of Civil Procedure 38 and, so far as this record shows, any right to a jury trial was waived.

**Question No. 3.**

Assertion is also made that review is necessary because of alleged failure of the District Court to make findings of fact concerning ownership of the "disputed patent" (Petition p. 9).

Presumably the "disputed patent" is Chrysler's U. S. Patent No. 3,109,416. This patent, on its face is assigned to Chrysler and Petitioner never attempted to prove other-

wise. Contrary to Petitioner's assertion the District Court made the following oral findings (Petition, App. A) at conclusion of trial and written supplemental findings and conclusions (App. B) after trial:

> Now, the only other evidence that the plaintiff has produced in this Court as to General Motors, there is no evidence, none whatsoever in my opinion, that any overt acts has been proven or any overt act can be inferred that any body in Beale's office gave or exposed anything to General Motors. Conversely, there is no evidence that General Motors agents, surreptitiously or otherwise acquired any information from these attorneys in reference to this idea. So on the transferring it, it would have to be dismissed for want of evidence, total lacking of evidence. (Petition p. 2a.)

> The plaintiff objects to many of General Motors' proposed supplemental findings [joined in by Chrysler] but proposed none of his own.

* * * * *

> The Court finds that plaintiff totally failed to support his charge that the defendants, General Motors Corporation and Chrysler Corporation, stole or in any manner illegally acquired the alleged invention he disclosed to his patent attorneys, defendants Beale and Jones. (Petition p. 16a.)

> He produced no evidence whatsoever that his idea was transmitted to General Motors or the Chrysler Corporation by word of mouth or otherwise.

* * * * *

> The plaintiff claims that his idea was incorporated in the Kolbe patent and in Chrysler Patent No. 3,109,416. However, he produced no expert testimony to support this contention. To the contrary, the evidence disclosed that he took the Kolbe patent to his patent attorneys, Beale and Jones, and that they advised him that "Kolbe's claim cannot be read on your disclosure." (Petition p. 17a.)

> Further, the plaintiff's evidence failed to disclose any licensing arrangement or any connection between General Motors and Chrysler relating to intake manifolds. (Petition p. 18a.)
>
> The plaintiff's case, upon motion of the respective defendants, was dismissed at the conclusion of his case solely because he failed to produce sufficient evidence to *prima facie* establish any of his claims. (Petition p. 19a.)

For Petitioner to ask more than the above in the way of findings of fact and conclusions is nothing more than academic at best, particularly when viewed from the standpoint that he offered no evidence whatsoever that he should own the patent rather than the owner Chrysler. *Switzer Bros. Inc. v. Locklin*, 297 F. 2d 39, 45 (7th Cir., 1961); cert. denied 369 U.S. 851.

## Conclusion

For the foregoing reasons it is respectfully submitted that this petition for writ of certiorari should be denied.

Respectfully submitted,

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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1970

No. 873

ST. ELMO HAWKINS,
Petitioner,

v.

GENERAL MOTORS CORPORATION, GEORGE R. JONES, T/A BEALE AND JONES, and CHRYSLER CORPORATION,
Respondents.

## BRIEF IN OPPOSITION TO PETITION FOR CERTIORARI

### INTRODUCTION

The Petition does not present any crucial questions, constitutional or otherwise, of any public importance warranting review by this Court. Petitioner alleged that his attorneys Beale and Jones divulged his alleged invention to General Motors, which in turn obtained a patent thereon. The District Court, after hearing Petitioner's evidence, granted Respondents' motions to dismiss. The Court of Appeals affirmed. The only real issue in this case is the purely private issue of whether Plaintiff made a *prima facie* case. That issue has been decided.

I.

No jury demand was made until January 24, 1969, nine months after the last amended answer had been filed. At this time, the trial date had been set.[1] The District Court proceeded to hear the case without a jury on February 17, 1969. Petitioner was given every opportunity to prove his case. When Petitioner rested, the Respondents moved to dismiss for failure to make out a *prima facie* case. The Trial Judge then made tentative findings of fact, but deferred ruling on the motions so as to give Petitioner time to cite any evidence contrary to the tentative findings (TR. 547-562). On February 19, 1969, the Trial Judge heard oral argument on Respondents' Motions to dismiss. He then rendered a second opinion dismissing Petitioner's complaint against Respondents for lack of evidence.[2] Judgment was entered on March 6, 1969.

II.

Petitioner contends that his demand for a jury trial was timely, and that the denial of a jury trial was an abridgement of Petitioner's right under the Seventh Amendment to the Constitution. Both contentions are wrong. Petitioner's demand for a jury trial was endorsed on a Motion to Amend the Amended Pleadings, filed during the formal pretrial conference on January 24, 1969.[3] This was long

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[1] A notice setting trial by Court was sent out on November 27 1968.

[2] Petitioner's Brief, Ap. A., pp. 1a-19a.

[3] Petitioner's Brief, Ap. F., p. 24a. These amendments did not change the issue for trial as framed by the Trial Judge and agreed to by all parties (TR. 144, 145).

after expiration of the 10-day period of Rule 38(b). The Trial Judge was plainly correct in denying the demand.

But even if the demand was timely, the error was harmless. The District Court heard all the evidence Petitioner had. The Trial Judge used the jury trial standard in evaluating Petitioner's evidence and concluded that the evidence did not make a *prima facie* case.[4] If a jury had been present, there would have been a directed verdict for Respondents.[5] It follows that if there was error below in denying the demand for a jury trial, it was a harmless error which would not have affected the outcome of the litigation.

## III.

Petitioner does not change the situation by the contrived question of whether Rule 38(d) is unconstitutional. We don't think there is any real question of constitutionality. But if there were, this is not the case for decision as to it. Petitioner has had his day in Court, he failed to make out a *prima facie* case, and there is no issue for jury consideration in any event. As pointed out by this Court in *Light v. United States*, 220 US 523, 538 (1911):

> "For, as said in *Siler v. Louisville & N. R. Co.*, 213 U.S. 193, . . . 'where a case in this court can be decided without reference to questions arising under the Federal Constitution, that course is usually pursued, and is not departed from without important reasons.'"

As stated by Mr. Justice Brandeis in *Ashwander v. Tennessee Valley Authority*, 297 U.S. 288, 347 (1935):

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[4] Petitioner's Brief, Ap. A., p. 1a.

[5] Petitioner's Brief, Ap. A., p. 8a.

> "The Court will not pass upon a constitutional question although properly presented by the record, if there is also present some other ground upon which the case may be disposed of. This rule has found most varied application. Thus, if a case can be decided on either of two grounds, one involving a constitutional question, the other a question of statutory construction or general law, the Court will decide only the latter."

## IV.

Petitioner also seeks reversal because of the failure of the District Court to make specific subsidiary findings of fact regarding patent ownership. We perceive no reason why the District Court should have made such findings, and Petitioner's brief does not state one.[6] In any event, this failure was at most an incomplete adjudication of a private controversy. It falls far short of a substantial issue of public importance, justifying review by this Court.

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This is a private controversy that was decided below after a trial where Petitioner did not make out a *prima facie* case. The petition should be denied.

Respectfully submitted,

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[6] Moreover, Petitioner neither proposed nor requested the District Court to make any fact findings.